

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

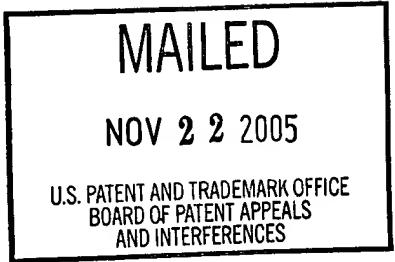
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SANDRINE DECOSTER, VERONIQUE DOUIN
and VIRGINIE BAILLY

Appeal No. 2005-1339
Application No. 09/692,155

HEARD: August 9, 2005



Before WILLIAM F. SMITH, SCHEINER and MILLS, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-71, 73, 74, 81-85, 94 and 95. Claims 86-92 are also pending, but have been withdrawn from consideration.

The claimed invention is directed to a cosmetic composition comprising "at least one conditioner chosen from: synthetic oils; animal oils; plant oils; fluoro oils; perfluoro oils; natural waxes; and synthetic waxes;" and at least one silicone copolymer having a specific formula and range of dynamic viscosity, wherein the composition is in a form chosen from, among other things, "an aqueous lotion, an aqueous-alcoholic lotion, a gel, a milk, a cream, an emulsion, a thickened lotion, and a mousse" (claim 1). Certain of the claims (e.g., claim 18) additionally require at least one surfactant selected from certain quaternary ammonium salts. The claims on appeal are reproduced in the Appendix accompanying appellants' Brief on Appeal.

The references relied on by the examiner are:

Iwao et al. (Iwao)	4,183,917	Jan. 15, 1980
Dubief et al. (Dubief)	5,804,207	Sep. 8, 1998
Groh	5,863,943	Jan. 26, 1999
Restle et al. (Restle)	6,039,936	Mar. 21, 2000
Dalle et al. (Dalle) (published European Patent Office Application)	EP 0 874 017 A2	Oct. 28, 1998

The claims stand rejected as follows:

- I. Claims 1-16, 44-47, 56, 73, 74, 81-85, 94 and 95 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Dalle in view of Groh.
- II. Claims 1-16, 44-71, 74, 81-84, 94 and 95 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Dalle in view of Dubief.
- III. Claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94 and 95 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Iwao in view of Dalle.
- IV. Claims 18-24, 26, 28-43, 47-51, 60 and 65-69 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Iwao and Dalle and further in view of Restle.

OPINION

As an initial matter, we note appellants' indication that the claims "stand or fall together" (Brief, page 4). As there are four rejections of record, we understand appellants' position to be that the claims corresponding to each rejection stand or fall together. Therefore, we will consider the issues raised by this appeal as they pertain to representative claims 1 and 18. See 37 CFR 1.192(c)(7) (2002).

I. Dalle and Groh

The examiner rejected claims 1-16, 44-47, 56, 73, 74, 81-85, 94 and 95 as unpatentable over the combined teachings of Dalle and Groh. Dalle is directed to a

silicone in water emulsion which comprises a composition containing at least one polysiloxane and at least one organic silicon material that reacts with the polysiloxane by chain extension. Dalle, page 2, lines 3-5 and 30-34. We find that the polysiloxane is described in Formula I, page 3, lines 1-17, and is substantially the same as the formula of component (2) of the claimed subject matter. We find that R' may be a group required for the chain extension reaction and includes hydrogen, vinyl, allyl and hexenyl. Id., page 3, lines 12-13. We find that the second component that reacts with polysiloxane can likewise be a polysiloxane. Id., page 3, lines 25-26. We find that the reaction occurs between a polysiloxane having one reactive group and a second polysiloxane having a second reactive group which reacts with the first polysiloxane. Id., page 3, lines 26-29. We further find that the silicone copolymer formed has the identical viscosity range of 10^6 to 10^8 mm²/sec required by the claimed subject matter. Id., page 5, lines 40-41 and claim 16.

Based on the above findings, we conclude that the silicone copolymer of Dalle is the same as that of the claimed subject matter, there being no argument by appellants that the copolymer of the claimed subject matter is different from that described by Dalle.

Dalle makes no mention of oils or waxes, but teaches that his silicone copolymer emulsions are "useful in the standard applications for silicone emulsions" as "the silicone is lubricious and will improve the properties of skin creams, skin care lotions, moisturizers, facial treatments such as acne or wrinkle removers, [and] personal and facial cleansers" (Dalle, page 5, lines 47-50). Dalle further teaches that the silicone copolymer emulsions are "useful as a delivery system for oil and water soluble substances" (id.).

Groh describes skin conditioning lotions and creams comprising oil-in-water emulsions wherein the non-aqueous phase may be made up of mixtures of “traditional” mineral, animal and vegetable oils, natural or synthetic (column 2, lines 48-60 and column 3, lines 1-7), and “non-oil emollients including synthetic liquid silicone polymers” (column 2, lines 60-64 and column 3, lines 14-25).

We find no error in the examiner’s conclusion that claim 1 is unpatentable over the combined disclosures of Dalle and Groh. Appellants argue that “Dalle’s teaching that its silicone emulsion can be used in personal care lotions” is nothing more than “a suggestion . . . to embark on a wild goose chase to find other ingredients to include in these lotions” (Brief, page 7), and it is unreasonable to conclude that one skilled in the art, “[a]rmed with [Dalle’s teaching,] . . . would somehow find Groh and then incorporate Groh’s oils into Dalle’s lotions – expecting . . . to create a successful skin care composition” (*id.*). Appellants argue that finding a suggestion to combine silicone copolymers and oils in Dalle’s and Groh’s disclosures would be “an unreasonable extension of the concept of obviousness” that “would render obvious any known personal care ingredient in combination with Dalle’s silicone emulsion” (*id.*).

We do not agree that the rejection discussed here is based on the premise that combining “any known personal care ingredient . . . with Dalle’s silicone emulsion” would have been obvious. As discussed above, the suggestion to combine “traditional” oils (natural or synthetic; animal, vegetable or mineral) and silicone polymers in skin conditioning lotions and cremes is explicit in Groh (column 2, lines 48-64 and column 3, lines 1-7 and 14-25). Dalle teaches that his silicone polymers, the same as those required by claim 1, are useful in “standard applications for silicone emulsions” as they “improve the properties of skin creams [and] skin care lotions” (Dalle, page 5, lines 47-50). In our view, the evidence relied on by the examiner is sufficient to establish that

one skilled in the art would have found it obvious to combine a “traditional” oil, such as those taught by Dubief, with Dalle’s silicone copolymer, in a cream or lotion – all that is required to meet the limitations of representative claim 1. As discussed above, claims 2-16, 44-47, 56, 73, 74, 81-85, 94 and 95 fall with claim 1. Accordingly, we affirm the examiner’s rejection of claims 1-16, 44-47, 56, 73, 74, 81-85, 94 and 95 as unpatentable over Dalle and Groh.

II. Dalle and Dubief

Claims 1-16, 44-71, 74, 81-84, 94 and 95 stand rejected as unpatentable over the combined teachings of Dalle and Dubief. Dalle, discussed above, “fails to teach the oil and surfactants of [the] instant claims” (Answer, page 4). According to the examiner, Dubief “teaches the surfactants of [the] instant claims” (*id.*) and “also teaches using oil components” (*id.*, page 5) in shampoos and cleansers. “Given the teaching of the application of the silicone copolymer of Dalle in emulsion or shampoo compositions,” the examiner concludes that “it would have been obvious to one of ordinary skill in the art . . . to have looked to the prior arts such as Dubief because of an expectation of successfully producing an emulsion shampoo composition” (*id.*).

We disagree. At best, the evidence relied on by the examiner establishes that individual parts of the claimed invention were known in the prior art. As explained in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citations omitted):

Most if not all inventions arise from a combination of old elements . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. [] Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The examiner may establish a case of prima facie obviousness based on a combination of references "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Id., 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

It is true that Dubief mentions both silicones and oils as examples of "water-insoluble particles which may be dispersed in [shampoo and cleanser] compositions" (Dubief, column 6, lines 24-31), but the examiner has not pointed to anything in the reference which would have suggested combining the two components in a single composition (unlike the explicit suggestion in Groh, discussed above). In our view, the fact that both Dalle and Dubief concern shampoos and cleansers, without more, would not have been enough to lead one skilled in the art to combine Dalle's silicone copolymers with Dubief's oils, as required by the claims. Likewise, the fact that the prior art could have been modified in a manner consistent with appellants' claims would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). On this record, the examiner has not identified a reason or suggestion, stemming from the prior art, to combine the references in the manner claimed. Accordingly, we reverse the rejection of claims 1-16, 44-71, 74, 81-84, 94 and 95 under 35 U.S.C. § 103 as unpatentable over Dalle and Dubief.

III. Iwao and Dalle

Claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94 and 95 stand rejected as unpatentable over the combined teachings of Iwao and Dalle. Again, Dalle is discussed above. According to the examiner, Iwao describes “hair care compositions comprising synthetic oils . . . quaternary ammonium salts . . . [and] nonionic surfactants” (Answer, page 5), but the compositions do not include silicone copolymers. Nevertheless, the examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art . . . to have modified the composition of Iwao by adding the silicone copolymer emulsion as motivated by Dalle, because of the expectation of . . . provid[ing] enhanced conditioning benefits to the hair” (id., page 6), as Dalle “teaches that the silicone emulsion is useful in formulating hair products such as hair conditioner” (id.).

Again, in our view, the mere fact that both Dalle and Iwao concern hair care compositions, without more, would not have been enough to lead one skilled in the art to combine Dalle’s silicone copolymers and Iwao’s oils, as required by the claims. The fact that the prior art could have been modified in a manner consistent with appellants’ claims would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). On this record, the examiner has not identified a reason or suggestion, stemming from the prior art, to combine the references in the manner claimed. Accordingly, we reverse the rejection of claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94 and 95 under 35 U.S.C. § 103 as unpatentable over Dalle and Iwao.

IV. Dalle, Iwao and Restle

The examiner rejected claims 18-24, 26, 28-43, 47-51, 60 and 65-69 over “Iwao and Dalle as applied . . . above, and further in view of Restle” (Answer, page 6). Claim 18 requires certain cationic quaternary ammonium surfactants not taught by Iwao or Dalle. According to the examiner, Restle “teaches that the [required] quaternary ammonium surfactants are well known in the art . . . [of] personal care products” (*id.*), and “[i]t would have been obvious to one of ordinary skill in the art . . . to have modified the composition of the combined references^[1] by substituting the cationic surfactants there with the cationic amphiphilic lipids in Restle [] because of the expectation to have produced compositions which would provide similar glossy appearance, and softness on the hair” (*id.*, page 7).

This rationale does not address the underlying deficiency in the examiner’s proposed combination of Iwao’s and Dalle’s teachings, thus, on this record, the examiner has not identified a reason or suggestion, stemming from the prior art, to combine the references in the manner claimed. Accordingly, we reverse the rejection of claims 18-24, 26, 28-43, 47-51, 60 and 65-69 under 35 U.S.C. § 103 as unpatentable over Dalle, Iwao and Restle.

AN ADDITIONAL ISSUE

The examiner appears to have recognized that Restle “also teaches the use of synthetic oils including synthetic essential oils, polyethers, and silicone oils” (Answer, page 6). We further note that Restle discusses emulsions containing “animal or vegetable oils” (Restle, column 6, lines 55-57) and silicones, “for example decamethylcyclopentasiloxane or dodecamethylcyclohexasiloxane” (*id.*, column 7, lines

¹ We can only assume that “combined references” refers to Iwao and Dalle.

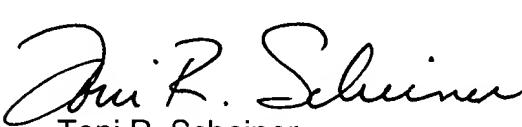
14-16) "as a mixture with at least one of the oils defined above" (*id.*). Nevertheless, this disclosure does not appear to have been incorporated into the examiner's proposed combination of the references. We would urge the examiner and appellants to consider whether Restle's disclosure is more relevant to the claimed invention than it would appear from the examiner's rejection.

DECISION

We have affirmed the rejection of claims 1-16, 44-47, 56, 73, 74, 81-85, 94 and 95 under 35 U.S.C. § 103 (a) as being unpatentable over the combined teachings of Dalle and Groh (Rejection I), but reversed the remaining rejections (Rejections II-IV). In addition, we have raised an issue for further consideration by appellants and the examiner.

AFFIRMED-IN-PART


William F. Smith
Administrative Patent Judge


Toni R. Scheiner
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES


Demetra J. Mills
Administrative Patent Judge

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413